

## REMARKS

Claims 35-49 and 51-65 were previously pending and have been amended in this Response. Applicants submit that no new matter has been introduced via the above-noted amendments, and as such, entry of the amendments and consideration of the following remarks is respectfully requested. Claims 35-49 and 51-65 are pending and submitted for consideration herein.

### **§102 REJECTION OVER *DORF***

Claims 35, 36, 38-42, 48, 49, 52, 53, 57-61, 63 and 64 were rejected under 35 U.S.C. §102(e) as being anticipated by *Dorf* (US Patent No. 6,000,608). The Office Action took the position that *Dorf* teaches each and every element recited in the rejected claims. Applicants respectfully traverse the rejection and submit that each of the rejected claims recites subject matter that is not taught or otherwise disclosed by the cited reference.

### **Applicants' Novel Features:**

More particularly, Applicants' independent claim 35 expressly recites a system for effecting electronic payment for goods or services that includes a payment processor in communication with a financial network that has a "database associating each of a plurality of intermediary account numbers with at least one corresponding end-user account number, wherein the intermediary account number is different from the end-user account number."

Similarly, Applicants' independent claim 40 recites a method for effecting payment for telephone services that includes associating an account identifier with an intermediary account number that represents an end-user's prepaid account maintained by a telecommunications provider. The method further includes storing the association in a database coupled to a central payment processor, wherein the association includes information that allows the central payment processor to identify the end-user's prepaid account when presented with the account identifier. Thus, when a payment transaction is conducted, payment is received from the end-user and a point-of-sale along with the account identifier, which is then communicated to a central payment processor, where it is validated and a response is sent to the point-of-sale. The payment processor also looks up the intermediary account number associated with the account identifier and sends a message to the telecommunications provider for loading value into the end-user's associated prepaid account using the intermediary account number and not the user's account identifier.

Similarly, Applicants' independent claim 48 recites a method effecting payment that includes establishing an intermediary account number in a database that is coupled to a centralized payment processor, associating the established intermediary account number with an end-user account identifier. The end-user account identifier is also associated with a corresponding vendor. The method further includes conducting a payment transaction by receiving a payment together with the end-user account identifier at a point-of-sale. The method further includes sending transaction data that includes an end-user account identifier from the point-of-sale to the centralized payment processor via a financial

network, validating the transaction, and transmitting a response to the point-of-sale. Further, the method includes crediting an indicia of monetary value to the associated intermediary account number in response to the payment transaction, wherein the crediting of the monetary value is not associated with the end-user account identifier.

Dorf Teaches:

Applicants submit that *Dorf* does not teach or disclose the intermediary account limitations recited in each of Applicants above noted independent claims. More particularly, *Dorf* teaches (in the sections cited by the Examiner – columns 7 and 8) a card system where a user presents a card 101 at a retailer and indicates the desired purchase amount, as shown in Figure 2. The retailer swipes the card 101 through a POS device 105, which communicates the card data, *i.e.*, the card identification number read from the card's magnetic strip 106, to the bank processor 208. The bank processor 208 communicates the card data (including the card identification number) over the debit network 107 to the sponsoring bank processor 102, which acts as a link between the debit network 107 and the processing hub 103.

Once the card data (including the card identification number) is received at the processing hub 103, the hub 103 recognizes the card identification number as representing a particular prepaid phone card issuer (from the BIN number) and forwards the card identification number to a specific issuer hub 104 that is maintained by the corresponding prepaid phone card issuer. The issuer hub 104 activates a record in a phone card database having the same identification number as the card 101, and a value field in this

record is updated to reflect the purchase amount. The issuer hub 104 then returns an authorization number back along the same path to the POS device 105, and the user may then use the authorization number to activate the purchased amount of time.

Distinctions:

Each of Applicants' claims require an intermediary account or an intermediary account number, which is not taught or disclosed by *Dorf*. As noted above, the card identification number is the only number used in the *Dorf* system from start to finish. More particularly, the card identification number is received at the point of sale 105 and transmitted through the entire system to the phone provider's database 104 without being changed or substituted. In *Dorf* there is no intermediary account number that is used between the point of sale and the phone provider's database, as in Applicants' claims. The card identification number is not changed in any way throughout the *Dorf* process (other than possibly being encrypted and decrypted). Thus, Applicants submit that *Dorf* clearly and expressly discloses using only the card identification number throughout the entire reload process, and as such, *Dorf* clearly fails to teach or disclose an intermediary account or intermediary account number, as required by each of Applicants' independent claims.

More particularly, Applicants' independent claim 35 requires "a payment processor in communication with the financial network and including a database associating each of a plurality of intermediary account numbers with at least one corresponding end-user account number, wherein the intermediary account number is different from the end-user account number." The payment processor of *Dorf* does not include a database in

communication with the payment processor that contains an association between an intermediary account number and an end-user account number, as *Dorf* uses only the card identification number obtained from the user's card throughout the entire process. Further, Applicants' independent claim 35 also requires a "crediting device in communication with the payment processor and being configured to credit an indicia of monetary value to an intermediary account number associated with the end-user account number." Again, since *Dorf* does not teach or disclose an intermediary account, it is clear that *Dorf* also cannot teach or disclose crediting a monetary value to an intermediary account number.

Although the Office Action at pages 4 and 14-15 takes the position that the teaching in *Dorf* of the "processing hub 103 recognizes the identification number of the card as being associated with a particular prepaid phone card issuer" constitutes an intermediary account, Applicants submit that a careful comparison of Applicants claim limitations that substitute the user's account/identification number with an intermediary account number before communicating with the phone provider are clearly not anticipated by the system of *Dorf*. More particularly, in *Dorf* the user's identification number or account number are used throughout the processing sequence in the *Dorf* system, *e.g.*, *Dorf* uses the same user identification/account number throughout the process and does not use an intermediary account or intermediary account number. The section cited on page 4 of the Office Action describes where *Dorf* credits the phone provider account that corresponds with the user account number taken from the user's card at the point of sale. However, this does not constitute an intermediary account or an intermediary account number, as recited

in Applicants' claims. There is no mention of any sort of intermediary account or intermediary account number in any of the sections of *Dorf* cited in the Office Action. After careful consideration of the cited prior art, Applicants respectfully submit that *Dorf* clearly fails to teach or disclose each and every limitation recited in independent claim 35, and as such, reconsideration and withdrawal of the anticipation rejection of claim 35 and all claims depending therefrom is respectfully requested.

Similarly, Applicants' independent claim 40 requires "associating an account identifier with an intermediary account number that represents an end-user's prepaid account maintained by a telecommunications provider;" "storing the association in a database coupled to a central payment processor;" and "looking up the intermediary account number associated with the account identifier." As noted above with regard to Applicants' independent claim 35, *Dorf* fails to teach or disclose an intermediary account, and therefore, *Dorf* also clearly fails to disclose each of Applicants' recited method steps in independent claim 40 that each include the intermediary account or the intermediary account number. Therefore, Applicants submit that *Dorf* fails to anticipate independent claim 40 for at least the same reasons that *Dorf* fails to anticipate claim 35, and as such, reconsideration and withdrawal of the rejection of independent claim 40 and all claims depending therefrom is respectfully requested.

Further still, Applicants' independent claim 48 recites a method for effecting payment for goods or services that requires "establishing an intermediary account number in a database that is coupled to the centralized payment processor;" associating the

intermediary account number with an end-user account identifier that is also associated with a corresponding vendor;" and "crediting an indicia of monetary value to the associated intermediary account number in response to the payment transaction." Again, *Dorf* clearly fails to disclose any sort of an intermediary account, and therefore, *Dorf* fails to disclose each of Applicants' limitations recited in independent claim 48. As such, Applicants submit that *Dorf* fails to anticipate independent claim 48, and reconsideration and withdrawal of the rejection of independent claim 48 and all claims depending therefrom is respectfully requested.

Therefore, in sum, Applicants submit that *Dorf* fails to teach or disclose the intermediary account limitations recited in each of Applicants' claims. As such, reconsideration and withdrawal of the rejection of claims 35, 36, 38-42, 48, 49, 52, 53, 57-61, 63 and 64 over *Dorf* is respectfully requested.

### **§103 REJECTION OVER DORF IN VIEW OF MUEHLBERGER**

Claims 37, 43, 45-47, 54, 55, and 62 were rejected under 35 USC §103(a) as being obvious over *Dorf* in view of *Muehlberger* (US Patent No. 5,696,908). The Office Action took the position that *Dorf* teaches each and every limitation recited in the rejected claims, except for the vending machine limitation. However, the Office Action cited to *Muehlberger* as teaching this limitation and concluded that it would have been obvious for one of ordinary skill in the art to have combined the teaching of the cited references to create the invention recited in the rejected claims. Applicants respectfully traverse the rejection and

submit that each of the rejected claims recites limitations that are not taught, shown, or even suggested by the cited prior art, when taken alone or in combination.

Applicants' independent claims are discussed above. *Muehlberger* teaches a prepaid telephone card for use in placing local and long distance calls. The telephone card is dispensed from a system having data processing and telecommunications means for communicating with multiple telecommunications carriers or switch and an electronic clearing house for initiating funds collection from the house and payment to a selected telecommunications carrier for each phone card transaction. A card value is selected by the customer for providing an activation code acceptable to the selected telecommunications carrier wherein each code permits prepaid purchasing from that carrier. The value selected is in response to a customer demand associated with an electronic funds transfer payment having the selected value. Customer identification sufficient for obtaining customer credit approval from an associated lender through the clearing house is received from the customer. A real-time communication is generated to the clearing house for determining validity and for initiating electronic funds collection. Customer identification validity is requested. Further, electronic funds transfer is initiated in the amount of the selected value. The card is then provided having the value and an activation code recognizable by the selected carrier. A real-time communication is then generated to the selected carrier for initiating electronic funds payment to the carrier along with the activation code for permitting phone card use by the customer immediately after the card is dispensed.



However, nowhere in *Muehlberger* is there any teaching, showing, or suggestion of an intermediary account or an intermediary account number, as expressly recited in each of Applicants' claims. As such, Applicants submit that *Muehlberger* fails to further the teaching of *Dorf* to the level necessary to properly support an obviousness rejection of Applicants' claims. Therefore, reconsideration and withdrawal of the rejection of claims 37, 43, 45-47, 54, 55, and 62 is respectfully requested.

Additionally, in *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that "a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known." *Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP § 2142:

*... The examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness...*

In the present application, a prima facie case of obviousness does not exist for the claims [as herein amended] for at least the following reasons:

1. The Examiner must show that all words in the claim have been considered.

MPEP 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). However, in the present matter, Applicants submit that the Office Action cannot show that all words in the claim have been considered. For example, each of Applicants’ claims require either an intermediary account or an intermediary account number. The Office Action has not cited to any teaching in either Dorf or Muehlberger that constitutes an intermediary account or an intermediary account number. As noted above in Applicants’ remarks with regard to the independent claims and the §102 rejection, the Office Action cites to columns 4 and 7 as teaching Applicants’ recited intermediary account. However, a careful reading of the cited sections does not support the Office Action’s conclusion, as Dorf uses only the user’s account/identification number throughout the processing sequence and does not at any point in the process replace or substitute in an intermediary account number, as Applicants’ claims each expressly require.

2. The cited references teach away from the claimed invention and cannot be used to establish obviousness.

KSR maintained the long-standing principal that “when the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be non-obvious.” KSR at 1740. In the present case, Dorf teaches that it is advantageous and more efficient in the processing sequence to utilize the user’s account/identification number throughout the entire processing sequence. Thus, Dorf clearly teaches away from Applicants’ claimed invention where the user’s account number

is substituted for intermediary account number in the processing sequence, as this substitution is viewed by Dorf as an inefficiency in the processing sequence. Thus, for this reason alone, the Office Action's burden of factually supporting a prima facie case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

Therefore, Applicants submit that the cited combination of *Dorf* and *Muehlberger* fails to render Applicants' claims obvious, as neither of the cited references, when taken alone or in combination, teaches, shows, or even suggests the intermediary account or the intermediary account number that is required by each of Applicants' claims. As such, reconsideration and withdrawal of the rejection of claims 37, 43, 45-47, 54, 55, and 62 under §103 over *Dorf* in view of *Muehlberger* is respectfully requested.

#### **§103 REJECTION OVER DORF & MUEHLBERGER IN VIEW OF RISAFI**

Claim 44 was rejected under 35 USC §103(a) as being obvious over *Dorf* in view of *Muehlberger*, further in view of *Risafi* (US Patent No. 6,473,500). The Office Action took the position that the combination of *Dorf* and *Muehlberger* teaches each and every limitation recited in the rejected claim, except for the collecting step being carried out in a batch mode on a daily basis. However, the Office Action cited to *Risafi* as teaching this limitation and concluded that it would have been obvious for one of ordinary skill in the art to have combined the teaching of the cited references to create the invention recited in the rejected claim. Applicants respectfully traverse the rejection and submit that the rejected

claim recites limitations that are not taught, shown, or even suggested by the cited prior art, when taken alone or in combination.

Applicants claim 44 depends from independent claim 40, which is presented above. *Risafi* teaches a method for using the prepaid card that includes purchasing a card issued by an issuer at a retail establishment via an agent terminal, selecting a PIN, selecting the opening account balance, having the card activated at the point of purchase, and, over time, using the card to purchase goods and/or services. The PIN and the card number are transmitted over a communications network to the card processing center to be stored in an account file associated with that card number. Also transmitted and stored in the account file is the amount of value purchased. The balance remaining on the card after a purchase or purchases are made will be kept in the account file.

However, nowhere in *Risafi* is there any teaching, showing, or suggestion of an intermediary account or an intermediary account number, as expressly recited in Applicants' claim 44. As such, Applicants submit that *Risafi* fails to further the teaching of *Dorf* and *Muehlberger* to the level necessary to properly support an obviousness rejection of Applicants' claim 44 under §103 of the Patent Laws. Therefore, reconsideration and withdrawal of the rejection of claim 44 is respectfully requested.

#### **§103 REJECTION OVER DORF IN VIEW OF CARSON**

Claim 51 was rejected under 35 USC §103(a) as being obvious over *Dorf* in view of *Carson* (US Patent No. 6,028,920). The Office Action took the position that *Dorf* teaches each and every limitation recited in claim 51, except for the account being a cellular phone

account. However, the Office Action cited to *Carson* as teaching this limitation and concluded that it would have been obvious for one of ordinary skill in the art to have combined the teaching of the cited references to create the invention recited in the rejected claim. Applicants respectfully traverse the rejection and submit that the rejected claim recites limitations that are not taught, shown, or even suggested by the cited prior art, when taken alone or in combination.

Applicants' claim 51 depends from independent claim 48, which has been presented above. *Carson* teaches a method for providing telephone service and cooperatively promoting the sale of telephone usage services by a telephone service provider and the sale of goods and/or services such as lottery tickets associated with a lottery game by a lottery service provider. However, nowhere in *Carson* is there any teaching, showing, or suggestion of an intermediary account or an intermediary account number, as expressly recited in Applicants' claim 51. As such, Applicants submit that *Carson* fails to further the teaching of *Dorf* to the level necessary to properly support an obviousness rejection of Applicants' claim 51 under §103 of the Patent Laws. Therefore, reconsideration and withdrawal of the rejection of claim 51 is respectfully requested.

#### **§103 REJECTION OVER DORF IN VIEW OF RISAFI**

Claims 56 and 65 were rejected under 35 USC §103(a) as being obvious over *Dorf* in view of *Risafi*. The Office Action took the position that *Dorf* teaches each and every limitation recited in claims 56 and 65, except for purchasing via the internet. However, the Office Action cited to *Risafi* as teaching this limitation and concluded that it would have

been obvious for one of ordinary skill in the art to have combined the teaching of the cited references to create the invention recited in the rejected claim. Applicants respectfully traverse the rejection and submit that the rejected claims recite limitations that are not taught, shown, or even suggested by the cited prior art, when taken alone or in combination.

Applicants' claims 56 and 65 depend from independent claims 48 and 40 respectively, both of which have been presented above. *Risafi* is also discussed above, and as noted above in Applicants' remarks, *Risafi* does not teach or disclose any sort of intermediate account or intermediate account number, as expressly recited in Applicants' claims 55 and 65. As such, Applicants submit that *Risafi* fails to further the teaching of *Dorf* to the level necessary to properly support an obviousness rejection of Applicants' claims 56 and 65 under §103 of the Patent Laws. Therefore, reconsideration and withdrawal of the rejection of claims 56 and 65 is respectfully requested.

### **Conclusion**

Applicants submit that none of the prior art references cited in the Office Action teach an intermediary account or an intermediary account number. The present invention is directed to substituting the user's account or identification number with an intermediary account number before interacting with the phone provider's hub or computer. This allows the user of Applicants' claimed invention to remain anonymous to the phone provider. Conversely, in *Dorf* the user's card number is passed through the system to the phone provider's database without being changed, thus not allowing the user to remain

anonymous. This is a key distinction between Applicants' claims and the prior art cited by the Office Action.

In view of the above noted distinctions, reconsideration and withdrawal of the rejections of Applicants' claims is respectfully requested. If the Examiner does not agree with Applicants distinctions, Applicant hereby requests a formal interview to discuss the merits of the application prior to the issuance of the next Office Action. The undersigned attorney of record can be contacted at the indicated phone number to schedule an interview. The Examiner's attention to scheduling this interview, if necessary, is greatly appreciated.

Respectfully submitted,



N. Alexander Nolte  
Registration No. 45,689

Dated: 5/8/08  
HAYNES AND BOONE, LLP  
Customer No.: 27683  
Telephone: 713/547-2156  
Facsimile: 214/200-0853  
Client Matter No.: 39048.21  
Document No.: H-724334v1

I hereby certify that this correspondence is being filed with the United States Patent and Trademark Office via EFS-Web on the following date.

Date MAY 8, 2008  
Michelle Baxter